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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,667	03/15/2002	Alex Mashinsky	5068-15	5716

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NEW YORK, NY 10176

EXAMINER

AL AUBAIDI, RASHA S

ART UNIT	PAPER NUMBER
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2614

MAIL DATE	DELIVERY MODE
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03/04/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/098,667

Applicant(s)

MASHINSKY ET AL.

Examiner

RASHA S. AL AUBAIDI

Art Unit

2614

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6 and 21-32 is/are rejected.
- 7) ☐ Claim(s) 33-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Pre-Brief conference request filed on 10/01/2008, PROSECUTION IS HEREBY REOPENED. New ground of rejection set forth below. Claims 1-3, 5-6 and 21-34 are pending.

Allowable Subject Matter

2. Claims 33-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 5 and 21-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khosla (US PAT # 5,884,277) in view of Examiner Official Notice and further in view of Segal (Pub.No. 2002/0161689).

Khosla teaches providing a purchaser (i.e., customer), who is interested in buying goods or services or making reservation for air line ticket to receive a coupon that can be redeemed for that transaction (see col. 1, lines 7-13, lines 60-67 and col. 2, lines 49-67). This coupon can printed at the customer premise and may be used at a later time (see col. 1, lines 22-26). The purchaser identity will be determined once the purchaser is ready to submit his/her purchaser or reservation (see col. 1, line 67 thorough col. 2, line 1).Khosla teaches the use of an internet as a method of communication that allows the user to place his/her order through the network as shown in Figs. 1-2 (see element description text in corresponding Figs. 1-2). Khosla also teaches that the preferred embodiments (I.e., the use of an on line transaction) has been presented for purpose of illustration but it is not meant to limit the invention, many modification and variation are applicable (see col. 5, lines 52-57).

Since Khosla does not teach receiving "a telephone call from an originating party" as recited in claim 1, the Examiner takes Official Notice that having a purchaser

(customer) using the phone instead of the Internet would have been obvious to one of ordinary skill in the art at the time the invention was made and well known in the art of telephony. It is also obvious to have the Khosla teachings applied in a public switched network environment where a purchaser can utilize the phone in order to place his/her order or reservation instead of using the internet as a method of communication in order to conduct his/her on line transaction. Utilizing the phone instead of the Internet , can offer some advantageous such as providing purchasers (customers) with speed and convenience by allowing the purchasers to utilize the phone at their premises or even their mobile phone devices if the use of internet (computer) is not available at certain time or places.

Even though the use of "database" as recited in claim 1, is obvious if not inherent limitation in Khosla, however, Khosla does not specifically teach that "a directory database that stores information associating contact information with the identity of the called terminating party".

The Examiner now introduces Segal which teaches in an automated ticket selling system, a listing database 300 (Fig.1) is provided to store listing of airline and pricing ticket for flights and customer data that are submitted to the server requesting air line reservation and flight pricing [see 0038-0045].

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of having a database that stores and correlates customers and business listings (such as airline reservation centers), as taught by Segal, into the combination of Khosla and Examiner's Official Notice in order to provide speed and efficiency when conducting and completing the transaction between an originating party (customer) and a destination party (any business or call center). Correlating the information will provide faster and more accurate information that can be utilized when serving and answering customer's requests. The claimed "processor" can read on element (20) as taught by Segal and shown in Fig. 1

Claims 3 and 5 are rejected for the same reasons as discussed above with respect to claim 1. The claimed "memory" as recited in claim 3 reads on element 22, as taught by Segal and shown in Fig. 1.

Claim 2 recites "the telephone call is a toll-free telephone call". This limitation is obvious and well known in the art.

For claims 21 and 23, see Khosla (col. 1, lines 22-24).

For claims 22 and 24, see Khosla (col. 2, lines 49-55).

Claims 5, 26 and 31-32 are rejected for the same reasons as discussed above with respect to claim 1. The use of "VOIP" or "identifying cookies or website" would be inherent if not obvious in the Khosla.

Regarding claims 27-30, Khosla teaches providing the coupon after the customer makes the payment for purchasing the airline ticket (see col. 2, lines 1-12)

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Khosla (US PAT # 5,884,277) in view of a Examiner Official Notice in view of Segal (Pub.No. 2002/0161689) and further in view of Jokinen et al. (Pub.No.: 2008/0120186).

The combination of Khosla, Examiner's Official Notice and Segal does not specifically teach that "providing targeted marketing materials to the originating party based on characteristics associated with the identity of the originating party" as recited in claim 6.

However, Jokinen teaches providing advertisers for distribution to mobile terminal users who match (i.e. meet) criteria set by the advertisers. At step 100, in addition to location database 35 and profile database 36, a criteria database 170, as shown in FIG. 12A, is created and maintained somewhere on the network, such as at advertisement server 40'. The criteria database 170 defines one or more group of criteria (e.g. demographics) and pricing, per criteria, for sending electronic coupons,

the pricing in the illustrated database 170 being based on the number of mobile terminal users (customers) to whom the electronic coupon is to be sent in accordance with criteria for selecting mobile terminal users specified by the service user (i.e. advertiser) [see 0051].

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the feature of sending advertisement, based on the information and criteria related to the user, as taught by Jokinen, into the combination of Khosla, Examiner's Official Notice and Segal in order to provide better customer service to users by offering what the users/consumers need and desire and not what the advertisers companies want.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S. AL-Aubaidi whose telephone number is (571) 272-7481. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (571) 272-7488.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

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information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rasha S AL-Aubaidi/

Primary Examiner, Art Unit 2614